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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,628	03/20/2001	David Lawrence	3499-92	1331

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BUCKLEY, MASCHOFF, TALWALKAR LLC  
5 ELM STREET  
NEW CANAAN, CT 06840

EXAMINER
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LIVERSEDGE, JENNIFER L

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/812,628	LAWRENCE, DAVID	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer Liversedge	3628	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/812,628 (March 20, 2001) filed on July 14, 2005.

The amendment contains amended claims 1-17 and 20.

The amendment contains original claims 18-19

The amendment contains canceled claims 21-22.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 3, 5-9, 11 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number US 2003/0135457 A1 to Stewart et al. (further referred to as Stewart).

Regarding claim 1, Stewart discloses a computer-implemented method (paragraphs 6, 7 and 9) to manage risk (paragraphs 20 and 49) related to opening a client account (paragraphs 7 and 9), the method comprising receiving digital information

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(paragraph 7) into a computer system relating to a client seeking to open the client account (paragraphs 7, 9 and 17); structuring the received digital information to a risk quotient criteria (paragraphs 43 and 45) associated with at least one of a financial, legal, regulatory and reputational risk of opening the client account (paragraphs 21 and 43); associating a weight with the risk quotient criteria (paragraph 20 where it is well known to those skilled in the art that logistic-regression modeling uses weights for making predictions); calculating a risk quotient based on the structured information and the weight associated with the risk quotient criteria (paragraphs 20 and 49); and generating a suggested action in response to the calculated risk quotient (paragraphs 20, 49 and 50).

Regarding claim 2, Stewart discloses a method further comprising storing data comprising the received information, the risk quotient, and the suggested action in a risk quotient criteria database (paragraphs 45 and 56); and generating a due diligence report based upon the stored data (paragraph 56).

Regarding claim 3, Stewart discloses a method wherein the due diligence report comprises a history of inquiries made relating to the client account and actions taken responsive to the risk quotient (paragraph 56).

Regarding claim 5, Stewart discloses the method wherein the received information is received from a source of electronic data (paragraphs 17 and 18).

Regarding claim 6, Stewart discloses the method wherein the suggested action is responsive to the received information (paragraphs 18, 20, 49 and 50).

Regarding claim 7, Stewart discloses the method wherein the suggested action is directed towards reducing at least one of a financial, legal, regulatory, and reputational risk associated with the client account (paragraphs 21, 43 and 49).

Regarding claim 8, Stewart discloses the method wherein the suggested action comprises blocking an opening of the client account (paragraph 49).

Regarding claim 9, Stewart discloses the method wherein the suggested action comprises notifying an authority concerning the received information (paragraph 49).

Regarding claim 11, Stewart discloses the method further comprising performing a calculation on the risk assumed by a financial institution as represented by the risk quotient (paragraphs 49 and 61 claim 5).

Regarding claim 20, Stewart discloses a computer executable program code residing on a computer-readable medium, the program code comprising instructions for causing the computer to receive digital information (paragraph 7) into the computer relating to a client account (paragraphs 7, 9 and 17); structure the received digital

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information according to a risk quotient criteria (paragraphs 43 and 45) associated with at least one of a legal, regulatory and reputational risk of opening the client account (paragraph 21); associate a weight with the risk quotient criteria (paragraph 20 where it is well known to those skilled in the art that logistic-regression modeling uses weights for making predictions); calculate a risk quotient based on the structured information and the weight associated with the risk quotient criteria (paragraphs 20 and 49); and generate a suggested action in response to the calculated risk quotient (paragraphs 20, 49 and 50).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4, 10, 14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart, and further in view of U.S. Patent Number US 2002/0143686 A1 to Greene et al. (further referred to as Greene).

Regarding claim 4, Stewart does not disclose the method further comprising presenting a graphical user interface to a network access device; displaying questions relating to the client account on the graphical user interface; and receiving information into the computer system responsive to the questions displayed.

However, Greene discloses the method further comprising presenting a graphical user interface to a network access device; displaying questions relating to the client account on the graphical user interface; and receiving information into the computer system responsive to the questions displayed. (paragraph 24).

It would be obvious to one of ordinary skill in the art to combine the graphical user interface for providing customer interaction as disclosed by Greene with the on-line computer method as disclosed by Stewart. The motivation would be to use the commonly implemented graphical user interface (GUI) tool with a browser to create a method of ease for customers interfacing with the browser while applying for a new account.

Regarding claim 10, Stewart does not disclose the method wherein the received information is received electronically from an external database. However, Greene discloses the method wherein the received information is received electronically from an

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external database (paragraph 26). It would be obvious to one of ordinary skill in the art to combine receiving information from a database as disclosed by Greene with the account opening method as disclosed by Stewart. The motivation would be to use the established technique of storing and transferring data as stored in databases in order to exchange client related data from the database instead of being entered by the client wishing to open the account.

Regarding claim 14, Stewart does not disclose the method wherein at least a portion of the received information is received in a pre-structured format. However, Greene discloses the method wherein at least a portion of the received information is received in a pre-structured format (paragraphs 24, 25 and 26).

It would be obvious to one of ordinary skill in the art to combine the method of receiving information in a pre-structured format as disclosed by Greene with the method of receiving client information as disclosed by Stewart. The motivation would be to receive information which would not require formatting following input.

Regarding claim 16, Stewart discloses a computerized system (paragraphs 6, 7 and 9) for managing risk (paragraphs 20 and 49) associated with opening a client account (paragraphs 7 and 9).

Stewart does not disclose a computer server accessible with a network access device via a communications network. However, Greene discloses a computer server accessible with a network access device via a communications network (paragraphs 20



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– 26). It would be obvious to one of ordinary skill in the art to combine the computer server and network as disclosed by Greene with the on-line client account opening computer system as disclosed by Stewart. The motivation would be to utilize computer servers and networks as standard known technology in the computer field for communicating across organizations for account authorization.

Stewart discloses executable software executable on demand (paragraph 17), the software operative to cause the system to receive digital information (paragraph 7) relating to the client account (paragraphs 7, 9 and 17); structure the received information according to risk quotient criteria associated with at least one of a legal, regulatory, and reputational risk of opening the client account (paragraph 21); associate a weight with the calculated risk quotient criteria (paragraph 20 where it is well known to those skilled in the art that logistic-regression modeling uses weights for making predictions); calculate a risk quotient based on the structured information and the weight associated with the risk quotient criteria (paragraphs 20 and 49); and generate a suggested action in response to the risk quotient (paragraphs 20, 49 and 50).

Regarding claim 17, Stewart discloses the computerized system wherein the software is further operative to cause the system to store data in a risk quotient criteria database, wherein the stored data includes the received information, the risk quotient, and the suggested action (paragraphs 45 and 56); and generate a due diligence report based upon the stored data (paragraph 56).

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Regarding claims 18 and 19, Stewart does not disclose the computerized system wherein the network access device is a personal computer or a wireless handheld device. However, Stewart does disclose the computerized system using the internet such that any user with access to the internet can obtain access to the system (paragraphs 4, 6, 7 and 9). It would be obvious to one of ordinary skill in the art that both personal computers and wireless handheld devices would be included within the set of devices by which a client would access the internet. The motivation would be to include both traditional desktop devices as well as portable devices for accessing the computerized system.

Claims 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart as applied to claim 1 above, and further in view of Dictionary of Economics by Wiley (1995) from [www.xreferplus.com](http://www.xreferplus.com) (further referred to as xreferplus).

Regarding claim 12, Stewart does not disclose the method further comprising aggregating a plurality of the risk quotients in order to calculate a total risk quotient representative of a total risk assumed by a financial institution. However, xreferplus discloses the method further comprising aggregating a plurality of the "risk quotients" in order to calculate a total "risk quotient" representative of a total risk assumed by a "financial institution" (page 1, lines 1 – 45 and page 2, lines 1-2). The method disclosed is that of determining a weighted average, which xreferplus defines, is that of combining a plurality of values in order to calculate a total value.

It would be obvious to combine the weighted average method as disclosed by xreferplus with the means of calculating a risk quotient as disclosed by Stewart in that the logistic-regression model as disclosed by Stewart uses weights in calculating values though Stewart does not discuss in detail the mathematical calculations involved within the disclosed logistic-regression model. The motivation would be to use established mathematical equations and models of combining factors in order to determine an aggregate value based on those factors.

Regarding claim 13, Stewart does not disclose the method further comprising calculating an average risk quotient based on a plurality of the risk quotients. However, xreferplus discloses the method further comprising calculating an average risk quotient based on a plurality of the risk quotients (page 1, lines 1 – 45 and page 2, lines 1-2).

The reasoning for combining xreferplus and Stewart as well as the motivation are the same as discussed in claim 12 regarding weighted average calculations.

Regarding claim 15, Stewart does not disclose the method wherein the risk quotient is calculated by multiplying a numerical value representative of a risk associated with the risk criteria times a numerical value indicative of a category weighting. However, xreferplus discloses the method wherein the risk quotient is calculated by multiplying a numerical value representative of a risk associated with the risk criteria times a numerical value indicative of a category weighting (page 1, lines 1 – 45 and page 2, lines 1-2).

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The reasoning for combining xreferplus and Stewart as well as the motivation are the same as discussed in claim 12 regarding weighted average calculations.

### ***Response to Arguments***

Rejections related to 35 USC § 112 and 35 USC § 101 have been withdrawn.

Applicant's arguments filed July 14, 2005 have been fully considered but they are not persuasive. The examiner has made every effort to address the Applicant's comments that the previous Office Action did not specifically point out which sections in the cited art the Examiner was referencing. In the current Office Action, the Examiner has addressed individual aspects of the claims, citing where references specifically teach the element as claimed. The presentation should be clear in the current format for Applicant's review.

The art used in the current Office Action addresses the Applicant's concern that the previously cited art did not specifically address legal, regulatory or reputational risk. The Applicant will find the current art relevant in the areas of risk cited, as well as financial as claimed within the application.

This Office Action is non-final as new art has been introduced in demonstrating prior art availability in teaching the Applicant's claims. The Examiner respectfully requests the Applicants to review the responses in the current Office Action relative to the claims in the application upon introduction of new art.


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**Conclusion**

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Jennifer Liversedge

Examiner

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